

In re Patent Application of:
TORRES ET AL.
Serial No. 09/774,393
Filed: **JANUARY 31, 2001**

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Examiner is also thanked for conducting a teleconference with the Applicants' Attorney regarding a response to this Office Action.

The specification has been amended to correct some minor deficiencies in the drawings that were helpfully pointed out by the Examiner with respect to patent reference numbers that were mentioned in the specification, but not included in the drawings, and further with respect to patent reference numbers included in the drawings, but not mentioned in the specification. Accordingly, the Applicants submit that the amendments to the specification address the objections to the drawings that were made by the Examiner.

The Claims have also been amended to correct some minor informalities that were helpfully pointed out by the Examiner. More specifically, independant Claim 43 has been amended to address the rejection under 35 U.S.C. §112. The Claims have further been amended to define the present invention over the prior art cited by the Examiner.

The Applicants have filed herewith a request for a two-month extension of time. The Commissioner is authorized to charge the Applicants' Attorney's deposit account for the two-month extension of time fee, and any additional fee that may be necessary.

The arguments supporting patentability of the present invention as recited in the amended Claims are found below.

I. The Invention

The invention, as recited, for example, in amended independant Claim 10, is directed to a prepaid healthcare

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service system comprising a plurality of prepaid healthcare patient identifiers for identifying information associated with a respective plurality of patients. Each one of the plurality of prepaid healthcare patient identifiers is associated with one patient and has a preselected number of prepaid healthcare consultations associated therewith. The prepaid healthcare service system also comprises a network of physicians.

The network of physicians comprises a plurality of physicians that provide healthcare consultations to the respective plurality of patients that possess the respective plurality of prepaid healthcare patient identifiers. Each of the plurality of physicians accept the plurality of prepaid healthcare patient identifiers to provide at least one of the preselected number of prepaid healthcare consultations associated with one of the respective plurality of prepaid healthcare identifiers taking place between one of the plurality of patients and one of the plurality of physicians. The plurality of prepaid healthcare patient identifiers are distributed by the plurality of physicians in the network of physicians so that the physician that distributes the plurality of prepaid healthcare patient identifiers receives payment for the prepaid healthcare consultations associated with the plurality of prepaid healthcare patient identifiers prior to providing the prepaid healthcare consultations.

The invention, as recited, for example, in amended independant Claim 43, is also directed to a method of providing a prepaid healthcare service system. The method comprises distributing a plurality of prepaid healthcare patient identifiers to a plurality of patients. Each of the plurality of prepaid healthcare patient identifiers identifies information associated with each of the plurality of patients,

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and also identifies a plurality of prepaid healthcare consultations between each of the plurality of patients and a plurality of physicians in a network of physicians. The plurality of patients define a plurality of members enrolled in the prepaid healthcare service system.

The method also includes identifying at least one of the plurality of physicians in the network of physicians to provide at least one of the plurality of prepaid healthcare consultations to at least one of the plurality of members enrolled in the prepaid healthcare service system. The method further comprises providing payments to the respective physician in the network of physicians that distributes the respective prepaid healthcare patient identifier upon distribution of the prepaid healthcare patient identifier so that the respective physician that distributes the respective prepaid healthcare patient identifier is provided payment prior to providing the prepaid healthcare consultation.

The invention, as recited, for example, in amended independent Claim 48, is also directed to a method of selling a plurality of prepaid healthcare consultations. The method comprises distributing a first plurality of prepaid healthcare patient identifiers each having a plurality of prepaid healthcare consultations associated therewith from a first individual physician in a network of physicians to a first plurality of physicians in the network of physicians and a first plurality of patients, so that the first individual physician receives payment for the prepaid healthcare consultations prior to providing the prepaid healthcare consultations.

The method also includes distributing a second plurality of prepaid healthcare patient identifiers having a plurality of prepaid healthcare consultations associated

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therewith from the first plurality of physicians to a second plurality of physicians in the network of physicians and a second plurality of patients. The first and second plurality of patients define members in a prepaid healthcare service system.

The invention, as recited, for example, in amended independent Claim 51, is still further directed to a method of providing a plurality of prepaid healthcare consultations. The method includes purchasing at least one prepaid healthcare patient identifier having a preselected number of prepaid healthcare consultations associated therewith from a healthcare provider. The healthcare provider distributes the at least one prepaid healthcare patient identifier upon receipt of a predetermined payment prior to providing the prepaid healthcare consultations, and the healthcare provider receives the predetermined payment prior to providing the prepaid healthcare consultation. The method also includes distributing the at least one prepaid healthcare patient identifier to at least one of the plurality of patients.

II. The Present Invention is Useful

The Examiner rejected Claims 10-15 and 43-54 under 35 U.S.C. §101, contending that the claimed invention is directed to non-statutory subject matter. More specifically, and with reference to page 5 of the Office Action, the Examiner notes that "the claimed invention must produce a useful, concrete, and tangible result". Yet, in the same paragraph, the Examiner finds that "the recited process produces a useful, concrete, and tangible result". Unfortunately, the Examiner provides no further explanation as to why she contends that the invention is not in the technological art. The Applicants submit, however, that the

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present invention, as recited in the amended claims, do apply, involve, use, and advance the technological arts to promote the progress of science and the useful arts.

More specifically, the present invention provides a system that includes a plurality of prepaid healthcare patient identifiers that are distributed to patients, and a network of physicians that accept the prepaid patient identifiers to provide the plurality of patients with prepaid healthcare consultations. As described above, the method aspect of the invention is directed to providing the prepaid healthcare service system, selling a plurality of prepaid healthcare consultations, and providing a plurality of prepaid healthcare consultations. Accordingly, Applicants respectfully submit that the present invention is useful, and meets the criteria set forth in 35 U.S.C. §101.

III. The Claims Are Patentable Over The Conklin Reference

The Examiner rejected independent Claims 10, 43, 48, and 51 under 35 U.S.C. §102(b) as being unpatentable over the Conklin reference. The Applicants submit, however, that the Conklin reference fails to disclose the claimed invention as recited in amended independent Claims 10, 43, 48, and 51.

The Conklin reference discloses "debit-card style health services" offered by a chiropractor. More specifically, the Conklin system discloses that a company or an individual may prepay for a certain number of chiropractic visits. A card may be carried by a user and may represent a plurality of chiropractic visits. The user may present the card at the chiropractic office and, after the visit, one unit may be deducted from the card. Payment is thereafter transferred to the doctor's bank account. The main goal of

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the Conklin system is to reduce healthcare overhead by reducing wasteful paperwork.

"One of the main benefits of the card is that providers get paid within 72 hours of rendering service rather than the standard three to six months" (see paragraph 6 of Conklin reference). Accordingly, the Conklin system requires a 72-hour payment waiting period for the provider that renders medical service. Accordingly, although the end user, i.e., the patient, may prepay for the chiropractic visit in the Conklin system, the prescriber, or medical professional, is not paid until three days after the medical services are rendered. The prepaid healthcare service system of the present invention, however, provides that the physician, or healthcare provider, receives payment for the prepaid healthcare consultations prior to providing the prepaid healthcare consultations. Accordingly, the prepaid healthcare service system of the present invention is truly a "prepaid" system.

The Applicants therefore submit that the Conklin reference fails to disclose that the physician, or healthcare provider, receives payment for the prepaid healthcare consultations prior to providing the prepaid healthcare consultations. Accordingly, the Applicants assert that amended independent Claims 10, 43, 48, and 51 are novel and define over the Conklin reference. The dependant claims, which recite yet further distinguishing features, are also patentable and require no further discussion herein.

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IV. The Claims Are Patentable Over Any Combination Of The
Conklin, Ushikubo '917, Dorf '608, and Link, II et al. '273
references.

The Examiner rejected dependent claims under 35 U.S.C. §103(a) as being unpatentable over various combinations of the Conklin reference, U.S. Patent No. 4,767,917 to Ushikubo, U.S. Patent No. 6,000,608 to Dorf and U.S. Patent No. 6,526,273 to Link, II et al. The Applicants submit, however, that any of the combinations cited by the Examiner still fails to disclose the claimed invention as recited in the amended claims.

U.S. Patent No. 4,767,917 to Ushikubo is directed to an automatic vending machine in which a key card may be used to purchase goods. A sale may be effected by the automatic vending machine only when a key card is verified as being valid.

U.S. Patent No. 6,000,608 to Dorf is directed to a multi-function card system that includes an encoded electronic gift certificate. More specifically, the multi-function card system provides a card that may function as a phone card, a debit card, a loyalty card, and a medical information card. In other words, Dorf '608 discloses combining the information on a plurality of cards into a single card.

U.S. Patent No. 6,526,273 to Link, II et al. is directed to a pre-paid wireless telephone system and method. More specifically, the system and method provide notification to customers that a wireless telephone account has been replenished. The notice may be delivered directly to the wireless telephone.

Applicants submit, however, that any combination of the Conklin reference, the Ushikubo '917 reference, the Dorf '608 reference and the Link, II et al. '273 reference still

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fails to disclose the claimed invention as recited in the amended claims. More specifically, any combination of the cited references fails to disclose a prepaid healthcare service system wherein a physician, or healthcare provider, receives payment for a plurality of prepaid healthcare consultations prior to providing the prepaid healthcare consultations.

Applicants also submit that no motivation exists to combine a debit-card style chiropractic system, as disclosed in the Conklin reference, with a vending machine that verifies and accepts a key card for payment, as disclosed in the Ushikubo '917 patent, and/or a multi-function system card, as disclosed in the Dorf '608 reference, and/or a prepaid wireless telephone system and method, as disclosed in the Link, II et al. '273 reference. More specifically, the Applicants submit that the Examiner has used improper hindsight reconstruction to combine the disjoint pieces of the cited references in an attempt to arrive at the present invention.

Accordingly, Applicants submit that the present invention, as recited in the amended claims, is patentable over any combination of the cited references.

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CONCLUSION

In view of the amendments to the claims and specification, and further in view of the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,




MARK R. MALEK
Reg. No. 46,894
The Torpy Group, P.L.
202 N. Harbor City Blvd.
Suite 200
Melbourne, Florida 32935
(321) 255-2332 Telephone
(321) 255-2351 Facsimile
Attorney for Applicants

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CERTIFICATE OF FACSIMILE

I HEREBY CERTIFY that the foregoing Amendment has been transmitted via facsimile to 703-872-9306 this 30th day of June, 2005.


Emily L. Kniss